

## REMARKS

### **I. Status of the Claims**

Claims 1-22 are pending in the application, and claims 2 and 12 stand withdrawn pursuant to a restriction requirement. Thus, claims 1, 3-11, and 13-22 are under consideration and stand rejected under 35 U.S.C. §112, second paragraph, 35 U.S.C. §102 and 35 U.S.C. §103. The specific grounds for rejection, and applicant's response thereto, are set out in detail below.

### **II. Improper Finality of the Action**

Applicant submits that the finality of the recent office action is improper. Each of the amended claims simply removed conditional limitations into new dependent claims. Thus, the total scope of the subject matter being claimed was neither narrowed nor broadened. As such, the reference now being applied could have just as easily been applied against the original claims and thus the new rejections were not caused by applicants' amendments. This action therefore should not have been made final. Reconsideration and withdrawal of the finality of the office action is therefore respectfully requested.

### **III. Rejections Under 35 U.S.C. §112, Second Paragraph**

Claims 1, 9 and 18 stand rejected under the second paragraph of §112 as indefinite. Each of these claims is rejected for the use of conditional language. Amendments are now provided that remove this language. These rejections were not caused by applicant's previous amendments, and could have been advanced earlier but were not. Reconsideration and withdrawal of the rejections is therefore respectfully requested.

#### IV. Rejection Under 35 U.S.C. §102

Claims 1, 4, 5, 8, 10, 11, 14, 18, 19 and 21 stand rejected under §102(e) over Hsu *et al.* The examiner states that Hsu discloses an antler extract composition comprising at least one amino acid selected from the group including Asn, Asp, Gln and Glu. This statement is false, but even if correct, would not support the rejection. Thus, applicant traverses.

The Hsu reference provides a list of possible amino acid components that includes *every single natural amino acid*. It does not call out four specific amino acids as alleged by the examiner, much less the 2 two-amino acid combinations as recited above – only that one or more of twenty different amino acids may be included. This is truly a generic disclosure.

It is black letter law that a genus does not anticipate a claim to a species within the genus unless the species is clearly named. *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). Here, a generic disclosure of all possible amino acid combination fails to anticipate the two combinations as claimed. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

#### V. Rejection Under 35 U.S.C. §103

Claims 9, 13 and 15-17 stand rejected under §103 as obvious over Hsu *et al.* No secondary reference is cited. Rather, the examiner alleges that the concentration of elements in the rejected claims cannot establish patentability.<sup>1</sup> Once again, applicant traverses.

As explained above, the examiner's original citation to Hsu *et al.* in the §102 rejection is both misleading and flat out wrong. There is no disclosure of selecting at least one amino acid from four specific residues (Asn, Asp, Glu and Gln), much less only two specific pairs of amino

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<sup>1</sup> The term "concentration" is inaccurate with respect to claims 13 and 15-17 as these recite pH's.

acids as actually claimed here. Thus, because there is no teaching of these specific limitations of the claims, obviousness cannot stand. The Supreme Court has held that a disclosure of all claim features is axiomatic since obviousness relies on ascertaining the differences between *the claimed invention* and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added). Indeed, applicant submits that this is why MPEP §904 instructs examiners to conduct an art search that covers “the invention *as described and claimed.*” (emphasis added). Lastly, applicant respectfully directs attention to MPEP § 2143, which buttresses the conclusion that obviousness requires at least a suggestion of all of the features of a claim, since the Supreme Court in *KSR Int’l v. Teleflex Inc.* stated that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Now, even if one were to take the Hsu reference seriously, what would it actually suggest about selecting amino acids combinations? Of all Hsu’s examples, only Example 2 lists specific amino acids. In that example, ten amino acids are listed, *but none of these are part of the claimed pairs*. Thus, even if one were to consider Hsu as relevant art, and to accept that it provides an enormous genus into which the specifically claimed invention would fall, it could not suggest the present invention as it actually teaches *away* from the claimed invention.


In sum, one can only support a conclusion obviousness when all the claimed elements *were known in the prior art*, and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-*

*Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art. Moreover, the reference actually specifies *other* residues than those claimed, and as such, constitutes a teaching away. MPEP §2145, citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Thus, any allegation that applicant's selection of particular amino acid pairs is obvious over Hsu is simply wrong. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

#### VI. Conclusion

In light of the foregoing, applicant respectfully submits that all claims are in condition for allowance, and an early notification to that effect is earnestly solicited. Should the examiner have any questions regarding the content of this response, a telephone call to the undersigned is invited.

Respectfully submitted,



Steven L. Highlander  
Reg. No. 37,642  
Attorney for  
Jurgen Frevert

FULBRIGHT & JAWORSKI L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
(512) 536-3184

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